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EXAMINER

BENNETT, RACHEL M

| | |
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| ART UNIT | PAPER NUMBER |
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1615

DATE MAILED: 11/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/610,320

Applicant(s)

AFRIAT ET AL.

Examiner

Rachel M. Bennett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-21 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-21 and 23-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s) _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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DETAILED ACTION

The examiner acknowledges receipt of Amendment C filed 8/20/02.

Specification

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-4, 11-15, 18-21, 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul et al. (US 5851539).

Mellul discloses water-in-oil emulsions that comprise fluorocarbon oils, water and a silicone surfactant (see abstract). The aqueous phase of the emulsion represents 10-90% by weight of the total formula of the emulsion (see col. 7 lines 50-52). Silicone surfactants disclosed include alkydimethicone copolyols, specifically "Q2 5200" (lauryl dimethicone copolyol). Other silicone compounds include alkoxymethylpolysiloxanes (see col. 7). These silicone surfactants are used in proportions of between 0.5 and 40% by weight relative to the weight of the emulsion. Additives, such as waxes, may be added to the composition and preferably do not exceed 50% by weight relative to the weight of the fatty continuous phase (see cols. 6 and 7). The continuous fatty phase may, in addition, contain screening agents, vitamins, hormones, antioxidants, preservatives, colorants, perfumes and any lipophilic additive customarily used in cosmetics (see col. 7 lines 46-49). The emulsions may be provided in the form of a milk, a cream for skin or hair care, anti-sun cream, foundation, lipstick, mascara or

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blusher (see col. 10 lines 37-45). Therefore, the cosmetic compositions prepared with these emulsions can be used for the treatment or care of the skin, the hair or the nails (see col. 10 lines 46-48).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the emulsion taught by Mellul in order to treat greasy skin because Mellul teaches the emulsion to be used to care for the skin and one would expect the emulsions to treat greasy skin by preventing water loss and protecting the skin from external damage as skin emulsions are known to do in the art.

3. Claims 1, 3-15, 18-21, 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul et al. (US 5851539), and further in view of Bara (US 5919468).

Mellul discloses water-in-oil emulsions that comprise fluorocarbon oils, water and a silicone surfactant (see abstract). Mellul does not disclose the silicone surfactant to be crosslinked elastomeric solid organopolysiloxane comprising at least one oxyethylene group.

Bara discloses the use of a partially crosslinked elastomeric solid organopolysiloxane in combination with a fatty phase for the preparation of a composition or in a composition for skin care or make-up for matting the skin. The cosmetic compositions are mild in application, easily spread, non-sticky and do not dry out the skin. They can be employed in particular for blurring out skin relief blemishes such as microreliefs, wrinkles or pores, while giving the skin a natural appearance. The organopolysiloxanes are disclosed in col. 2. The compositions may be in the form of water/oil emulsions in order to produce matting creams.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Mellul by substituting the crosslinked elastomeric

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solid oranopolysiloxane of Bara for the silicone surfactant of Mellul because of the expectation of producing a cosmetic composition for matting the skin, blurring out skin relief blemishes such as microreliefs, wrinkles or pores, while giving the skin a natural appearance as taught by Bara.

4. Claims 1, 3-4, 11-21, 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellul et al. (US 5851539), and further in view of Kang et al. (KR 9202286- Abstract only).

Mellul discloses water-in-oil emulsions that comprise fluorocarbon oils, water and a silicone surfactant (see abstract). Mellul does not disclose the addition of an electrolyte.

Kang discloses a water/oil type cosmetic preparation comprising of (a) oil phase componenets which contain 1.0-10 parts of methyl polysiloxane glycol copolymer and 1-20 parts liquid phase oil (b) water-phase components with contain 60-90 parts of purified water, 2-20 parts multivalent alcohol and 0.1-2.0 parts of a water-soluble electrolyte. Electrolytes are known in the art to be used in emulsions in order to minimize the tendency of materials present in the oil phase to also dissolve in the water phase.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Mellul by adding an electrolyte as disclosed by Kang because of the expectation of obtaining a stabilized emulsion as taught by Kang.

Response to Arguments

5. Applicant's arguments filed 8/20/02 have been fully considered but they are not persuasive. Applicant argues Mellul neither teaches nor suggests W/O emulsions containing at least 70% water and an aqueous phase of at least 75%. The examiner refers to Mellul, col. 7, line 51 wherein the aqueous phase could be 10 to 90% of the composition. Applicants argue Mellul does not indicate how much of the aqueous phase should be water. The examiner refers

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to col. 7 lines 45-67, wherein the aqueous phase may contain, in addition to water, a certain number of other water-soluble constituents which are often used in the cosmetic field, such as, polyols, such as propylene glycol, glycerol, polyglycerol, sorbitol, glucose in proportions not exceeding 80% by weight relative to the aqueous phase. It is the position of the examiner it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Mellul to include a high percentage of water because Mellul teaches the emulsions can be prepared for a broad range of water content depending on the desired formulation such as milk, cream, foundation, lipstick, mascara or blusher (see col. 10). Applicants argue Mellul's examples actually lead one skilled in the art away from the instant claims. The examiner refers to the ranges disclosed in cols. 6 and 7, wherein the instant ranges are disclosed by the reference. The test for 103 is based on the entire reference, not just the examples. Therefore, the reference teaches a) additives, such as waxes, do not exceed 50% by weight relative to the weight of the fatty continuous phase, b) water-soluble constituents, such as glycerol, do not exceed 80% by weight of the aqueous phase and c) the aqueous phase represent 10 to 90% of the emulsion. Thus, the disclosed ranges encompass the instant claims. Furthermore, Mellul discloses formulations such as cream, which read on the desired compression strength as in instant claim 1.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a solid composition which is "fresh" upon application to skin) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification

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are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel M. Bennett whose telephone number is (703) 308-8779. The examiner can normally be reached on Monday through Friday, 8:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (703) 308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 309-7924 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

R. Bennett: RMB
October 30, 2002

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
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